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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,895	10/02/2003	Masaki Kameyama	3531.68507	9667

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EXAMINER

DAVIS, DAVID DONALD

ART UNIT	PAPER NUMBER
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2627

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<div style="border: 1px solid black; width: 150px; height: 20px; margin-bottom: 5px;"></div> Office Action Summary	Application No. 10/677,895	Applicant(s) KAMEYAMA, MASAKI	
	Examiner David D. Davis	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7, 8, 10-13 and 15-22 is/are pending in the application.
 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-13 and 15-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No.

PCT/JP01/02949 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Response to Arguments

2. Applicant's arguments, filed August 25, 2005, September 19, 2005, February 17, 2006, August 11, 2006 and December 4, 2006, as well as the telephone interview June 12, 2007, with respect to assertion that applicant *did* distinctly and specifically point out the supposed errors in the restriction requirement have been fully considered and are persuasive. As a result, changes to the restriction requirement can be found below.

Election/Restrictions

3. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on December 2, 2004.

4. Applicant's election with traverse of Group I in the reply filed on December 2, 2004 is acknowledged. The traversal is on the ground(s) that "examination of all claims would not place an undue burden on the Examiner", and "The claims share several features, and a search for one group would probably overlap or encompass a search for the other group". This is not found persuasive because "examination of all claims *would* place an undue burden on the Examiner", and "The claims share several features, and a search for one group would *not* probably overlap or encompass a search for the other group".

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-5, 10-13, 15, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuishi (JP 2000-306226) in view of Higashiya et al (JP 06-012807). Furuishi et al shows in figure 2 a head slider 21 having an air inlet end and an air outlet end. Slider 21 includes a front rail 29 disposed on a disk-facing surface adjacent to the air inlet end and having a flat air bearing surface for generating a floating force when the disk rotates. Figure 2 also

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shows a pair of rear rails 36 & 37 disposed on the disk-facing surface adjacent to the air outlet end and each having respective flat air bearing surfaces for generating a floating force when the disk rotates. Figure 2 additionally shows a groove 22 defined downstream of the front rail 29 for expanding air once compressed by the front rail 29 to develop a negative pressure. Further shown in figure 2 is a plurality of pads 33 disposed on the front rail 29 and at least one pad 49 of said pair of rear rails 36 & 37.

Furuishi is silent, however, as to the head slider having a cavity on the air outlet end near the electromagnetic transducer 35 between the transducer and a rearmost portion of the head slider.

Higashiya et al shows in 1 the head slider 10 having a cavity 1 on the air outlet end near a rearmost portion of the head. Higashiya et al shows in figure 1 the cavity 1, which has a curved surface. Higashiya et al discloses that the depth of the cavity is between 10 - 50 μm , i.e. the depth of the cavity flows from approximation represented by: $z=f(x) \bullet g(y)$ where z represents the depth of the cavity 1, x represents the position thereof in the longitudinal direction of the head slider 10, and y represents the position thereof in the transverse direction of the head slider 10. Higashiya et al discloses that the depth of the cavity is between 10 - 50 μm , i.e. the cavity 1 is approximated by a curved surface which is represented by an equation which is similar to the equation except that at least one of $f(x)$ and $g(y)$ is replaced with a sine function.

Higashiya et al shows in figure 1 a portion of the head slider 10 that project from a disk-facing surface when a predetermined voltage is applied to the electromagnetic transducer. As the claims are directed to a head slider, per se, the method limitations appearing in line 2 of claim 4 has only been accorded weight to the extent that it affects the structure of the completed head

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slider. Higashiya et al also shows in figure 1 that an amount of material of the head slider would completely fill the cavity corresponding to a portion of the head slider which would project from the disk facing surface if the cavity were not present when a predetermined voltage is applied to the electromagnetic transducer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the slider of Furuishi with a cavity as taught by Higashiya et al. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to provide a slider with a cavity so as to catch “dust entering between a magnetic head slider and magnetic disk”. See the Abstract of Higashiya et al.

Response to Arguments

7. Applicant's arguments filed December 4, 2006 have been fully considered but they are not persuasive. In the paragraph bridging pages 12 and 13, “Applicant therefore formally request a telephone interview with both the Examiner and the Examiner’s Supervisor at least on this issue. The Examiner should contact Applicant’s representative at the number listed below to establish a time for the interview that is convenient to both Examiner and his Supervisor.” Applicant, as always, is invited to call the examiner and/or the examiner’s supervisor. The numbers for both are listed, *infra*, as they always are in each an every action mailed to the applicant. Furthermore, applicant also has the option to file a petition regarding the restriction requirement.

Again, with respect to traversal of the restriction requirement, applicant did not provide appropriate showings or evidence, as required by the MPEP, by way of a simple direct denial

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that the examination of the claims would not place an undue burden on the Examiner. Applicant merely provided a conclusory statement that the “claims share **several** features, and a search for one group **would probably** overlap or encompass a search for the other group.” Emphasis added. Whether or not claims share several features, which applicant failed to provide an appropriate showing of evidence of that assertion, is not a demonstration of a serious burden being lacking.

Applicant asserts that the combined references are silent as to the claimed limitation “said head slider having a cavity on the air outlet end near said electromagnetic transducer between the transducer and **a rearmost portion** of the head slider.” Emphasis added. It should be noted, since applicant appears to be suggesting this, that the claims require a rearmost portion not an edge, not the end, but a rearmost portion. In other words, the cavity is only required to be between the transducer and a portion, section or location **near or close to** the rear. It is understandable that applicant has imparted a narrow interpretation to the limitation “a rearmost portion” because the figures of the instant application do show the cavity at the edge or end of the slider.

Applicant asserts that Higashiya only teaches the numerical depth of the recess not the relationship of the dimensions of the cavity. It sound like the applicant is suggesting that the dimensions of the cavity vary with the formula, as opposed, to the dimension of the cavity being determined or approximated by the formula, as required by the claims and disclosed by the specification. The specification, which the claims are to read in light of the specification, states in the ultimate paragraph on page 17 the depth of the cavity, and the Higashiya cavity depth is well within the range of the claimed formula and the disclosed formula.

Furthermore, applicant asserts on page 18 that “the Examiner still does not even assert that either reference teaches or suggest any such formulae for, or relationships between, the dimension of the cavity”. The claims set forth are product claims. As the claims are directed to a head slider having a cavity, per se, the formulae for, or relationships between, the dimensions of the cavity have only been accorded weight to the extent that it affects the structure of the completed a head slider having a cavity. Determination of the claims is based on product itself, even though such claims are limited and defined by formulae for, or relationships between, the dimensions of the cavity. Furthermore, formulae for, or relationships between, the dimension of the cavity note is reciting subject matter of claims in terms of how the dimensions of the cavity it is obtained in the product claim.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is 571-272-7572. The examiner can normally be reached on Monday thru Friday between 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David D. Davis/
Primary Examiner
Art Unit 2627

ddd